

REMARKS

Claims 1-8 are in the application. Claims 5-7 are withdrawn from consideration as being drawn to a non-elected invention. By the present amendment, claim 1 is amended for clarity, and claims 6 and 7 are cancelled without prejudice or disclaimer. Support for the amendments to Claim 1 is found in paragraphs 14 and 15 of the present application. Claim 8 is also characterized as being previously presented since Claim 8, which depends from Claim 1, was first introduced into the application by the preliminary amendment filed on December 30, 2003.

In view of the amendments, reconsideration of claims 1-4, and consideration of claim 8 are respectfully requested.

§ 112 Rejections

Claims 1-4 are rejected under 35 U.S.C. 112, first paragraph. The Patent Office contends that the claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one of ordinary skill in the relevant art that the inventors had possession of the claimed invention at the time the application was filed.

Claim 1 has been amended to recite that the claimed method is for preparing a genomic expression library of a first bacterium which potentially contains a gene insert that encodes a product that is toxic to a second bacterium. The method comprises the steps of partially, digesting the genome of the first bacterium to provide genetic inserts, cloning and ligating the genetic inserts into a cloning vector, and directly transforming the ligation products into yeast. Applicants have shown that such method produces yeast clones containing plasmids that, when isolated from said yeast clones and transformed into a second bacterium, retarded the growth of certain clones of the second bacterium. (See the Example, particularly paragraphs 65-68 and Figure 2.) In view of these results, applicants submit that one of ordinary skill in the art would understand and appreciate that applicants had discovered a method for increasing the complexity of a bacterial genomic expression library by avoiding transformation of the genetic inserts into a bacterial host prior to transforming the yeast host with said inserts, and that applicants had found new way to produce a bacterial genomic library which potentially contains a genetic insert whose product is toxic to a second bacterium. Accordingly, applicants submit that claim 1, as amended,

Appl. No. 10/024,659
Amdt. dated July 26, 2004
Reply to Office Action of March 25, 2004

meets the written description requirement of 35 USC § 112. Claims 2-4 and Claim 8 all depend from Claim 1, and for the same reasons, meet the written description requirement of §112.

Claims 1-4 are rejected under 35 USC § 112, second paragraph. The office contends that the claims omits an essential step of : "determining the gene in the first bacterium that would be toxic to the second bacterium". In view of the amendment to claim 1, which now recites a library that "potentially" contains a gene that is toxic to a second bacterium, applicants submit that claim 1 recites all the essential steps of the claimed method. Accordingly, applicants request that the rejection be withdrawn. Claims 2-4 and Claim 8 depend from Claim 1, and, for the same reasons, meet all the requirement of USC 112, second paragraph.

In view of the present amendments and remarks,. Applicants submit that claims 1-4 and 8 are now in condition for allowance. Prompt notification of such allowance is respectfully requested.

Respectfully submitted,

Date:

July 26, 2004

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